

**REMARKS**

In the final Office Action mailed July 17, 2008 (hereinafter, "Office Action"), the Examiner rejected claims 18, 20, and 23-33 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,896,618 to Benoy et al. (hereinafter, "Benoy").

By this response, Applicants propose to amend claims 18, 20, 23-26, 32, and 33. Claims 1-17, 19, 21, and 22 were previously canceled. No new matter has been added. Accordingly, claims 18, 20, and 23-33 would remain pending.

In light of the foregoing proposed amendments and based on the remarks presented below, Applicants respectfully traverse the rejection of the claims under 35 U.S.C. § 102(e), and request reexamination and reconsideration of pending claims 18, 20, and 23-33.

**I. Rejection Under 35 U.S.C. § 102(e)**

Applicants respectfully traverse the rejection of claims 18, 20, and 23-33 under 35 U.S.C. § 102(e) as being anticipated by Benoy. "A proper anticipation rejection requires that "each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131. In addition, "[t]he elements must be arranged as required by the claim . . ." Id. (emphasis added). Applicants respectfully submit that Benoy fails to disclose all of the subject matter recited in the proposed amendments to independent claims 18, 24, 26, 32, and 33, and also fails to disclose the elements as arranged by the independent claims.

**A. Claims 18, 20, and 23-31**

Benoy fails to disclose the recitations of proposed amended independent claim 18, including, *inter alia*,

“(a) registering identification information unique to the player on the server device; [and]

(b) after the registering, allowing the player to store on the server device an optional message in advance in association with the registered identification information and in association with an event of the game to be played, which is designated by the player who expects the event to occur during a progress of the game to be played before allowing the player to start the game on the arcade game machine, said optional message being arranged to be sent from the server device to a terminal device optionally designated in advance by the player . . . .”

In the Office Action, the Examiner alleges that column 5, lines 33-52 of Benoy “discloses [that] players are expected to input identification information at a terminal to which a reply message is sent back to the player such as the player’s identification number.” Office Action, p. 7. However, even assuming the Examiner is correct, which Applicants do not concede, Applicants respectfully note that Benoy discloses “receiving a registration request message containing loyalty program information and loyalty program instrument information from a gaming machine” and “storing the loyalty program information and the loyalty program instrument information in a loyalty program account.” Benoy, 5:36-38, 41-42, and 44-46. In other words, Benoy discloses the storage of the contents of a single message by a server.

In contrast to the disclosures of Benoy, the proposed amendments to claim 18 include, *inter alia*, “(a) registering identification information unique to the player on the server device,” and “(b) after the registering, allowing the player to store on the server device an optional message in advance in association with the registered identification information . . . .” In other words, the game system of claim 18 is configured so that the player may store an optional message after registering identification information and

before the game is started. Such a configuration is not taught by Benoy. Indeed, Benoy does not disclose “an optional message,” as recited in proposed amended independent claim 18.

Moreover, Benoy also fails to disclose the proposed claim 18 recitation of “said optional message being arranged to be sent from the server device to a terminal device optionally designated in advance by the player.” Instead, Benoy discloses that “a registration reply message [is sent] **to the gaming machine.**” Id. at 5:36-38 and 41-42 (emphasis added).

For at least the above-outlined reasons, Benoy fails to disclose all of the subject matter recited in Applicants’ proposed amended independent claim 18. Therefore, the rejection of independent claim 18 under 35 U.S.C. § 102(e) should be withdrawn, and the claim should be allowed.

The proposed amendments to independent claims 24 and 26, although of different scope, recite elements similar to those of proposed amended independent claim 18, and are allowable for at least similar reasons. Therefore, for at least the same reasons as set forth above in connection with proposed amended independent claim 18, the rejection of independent claims 24 and 26 under 35 U.S.C. § 102(e) should be withdrawn, and the claims should be allowed.

Claims 20, 23, and 27-28 depend from proposed amended independent claim 18. Claims 25 and 29-30 depend from proposed amended independent claim 24. Claim 31 depends from proposed amended independent claim 26. As discussed above, Benoy does not support a rejection of independent claims 18, 24, and 26.

Therefore, dependent claims 20, 23, 25, and 27-31 are allowable for at least the same reasons as set forth above in connection with their corresponding independent claims.

Moreover, because Benoy fails to disclose “an optional message,” as recited in Applicants’ proposed amended independent claim 18, from which claim 20 depends, Benoy must necessarily also fail to disclose the additional proposed claim 20 recitation of “wherein the optional message is stored on the server device in association with a certain value of points to be acquired by the player before starting the game.” For similar reasons, Benoy must also necessarily fail to disclose the additional proposed amendments to claim 23, including “wherein plural ones of the optional messages are stored in relation with certain values of game points, respectively, one of which is given to the player in accordance with a result of the game executed by the player.” Indeed, Benoy provides no disclosure corresponding to “a certain value of points to be acquired by the player before starting the game,” as recited in proposed amended claim 20, or “certain values of game points,” as recited in proposed amended claim 23.

With respect to claim 25, the Examiner alleges that Benoy discloses that “[a] plurality of messages are displayed such as time of reservation and restaurant selections.” Office Action, p. 4. However, even if the Examiner’s allegation is correct, an assertion to which Applicants do not assent, this disclosure of Benoy does not correspond to the proposed claim 25 amendments, including, *inter alia*, “wherein said optional message contains plural messages which are stored in relation with certain game stages or statuses as said event designated in advance by the player, respectively.”

Claim 28, which depends from proposed amended independent claim 18, includes the additional requirement of “an opponent player.” Similarly, claim 30, which depends from proposed amended independent claim 24, includes the additional recitation of an “opponent player.” However, Benoy provides no teachings of “an opponent player.”

Finally, with respect to claim 31, Applicants respectfully note that the Examiner neglected to include any citations to Benoy in the rejection of dependent claim 31. Indeed, Benoy does not appear to teach the additional recitations of proposed amended dependent claim 31, including, *inter alia*, “wherein said designated terminal device is either the other of the plurality of game apparatuses on which the other player plays the game or a mobile terminal device which the other player carries.”

Therefore, for these additional reasons, Benoy does not support a rejection of independent claims 20, 23, 25, 28, and 30-31. Therefore, dependent claims 20, 23, 25, 28, and 30-31 are allowable for at least these additional reasons.

## B. Claims 32 and 33

Benoy fails to disclose the recitations of proposed amended independent claim 32, including, *inter alia*,

“(a) registering identification information unique to each player so that the one player on the one of the plurality of game apparatuses can play the game against the another player on the another of the plurality of game apparatuses;

(b) allowing the one player to store on the server an optional message in advance by way of a mobile terminal device operated by the one player, said optional message being a message arbitrarily prepared or designated by the one player, stored on the server in relation to the registered identification information and in relation to an event of the

game to be played, which the one player expects to occur during a progress or as a result of the game, and arranged to be displayed on a terminal device designated in advance by the player . . .”

As discussed above in connection with proposed amended independent claim 18, Benoy discloses the receipt and storage of a single registration request message by a server. Benoy does not disclose registration information, as in (a) and, separately, “an optional message,” as recited in (b) of proposed amended independent claim 32.

Moreover, Benoy also fails to disclose the additional claim 32 recitation of “said optional message being a message arbitrarily prepared or designated by the one player . . .” Instead, Benoy discloses that “a registration request message” is sent to the server, and “a registration reply message” is received by the gaming apparatus. That is, Benoy discloses specific messages that are pre-defined and determined. Benoy does not disclose that a message can be “arbitrarily prepared or designated by the one player,” as required by the proposed amendments to independent claim 32.

For at least the above-outlined reasons, Benoy fails to disclose all of the subject matter recited in Applicants’ proposed amended independent claim 32. Therefore, the rejection of independent claim 32 under 35 U.S.C. § 102(e) should be withdrawn, and the claim should be allowed.

Independent claim 33, although of different scope, recites elements similar to those of independent claim 33, and is allowable for at least similar reasons. Therefore, for at least the same reasons as set forth above in connection with proposed amended independent claim 32, the rejection of independent claim 33 under 35 U.S.C. § 102(e) should be withdrawn, and the claim should be allowed.

## II. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 18, 20, and 23-33 in condition for allowance. Applicants submit that the proposed amendments of claims 18, 20, 23-26, 32, and 33 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final Action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified

herein, Applicants do not automatically subscribe to any statement or characterization in the Office Action.

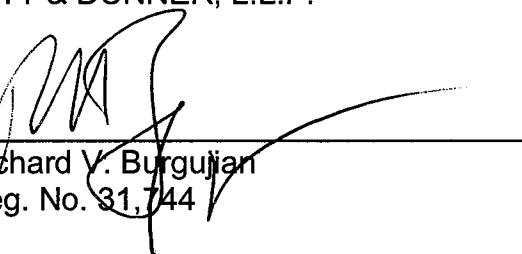
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 17, 2008

By: \_\_\_\_\_

  
Richard V. Burguiere  
Reg. No. 31,744